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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/276,807	03/26/1999	HIDEHIKO KAMEYAMA	DP-462US	2650

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT	PAPER NUMBER
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2644

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DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/267,807

Applicant(s)

TOGASHI ET AL.

Examiner

Jefferey F Harold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1-5, 7 and 8** are rejected under 35 U.S.C. 102(e) as being anticipated by Schlachman et al. (United States Patent 6,504,925), hereinafter referenced as Schlachman.

Regarding **claim 1**, Schlachman discloses an apparatus for enabling a telephone user to obtain telephone directory information. In addition Schlachman discloses a storage section (34, 36, and 38) for storing therein a name of a city/state and a corresponding telephone number thereto, as exhibited in figure 1;

a means for retrieving the name of the city/state from the storage section while the telephone number is entered from the input means (key board 22 or 40) to be a retrieval key, as disclosed at column 13, line 17 through column 16, line 54 and exhibited in figures 18 and 19;

a means for displaying (39) the name of the city/state which is retrieved, as disclosed at column 5, line 66 through column 6, line 50 and exhibited in figure 2.

Regarding **claim 2**, Schlachman discloses everything claimed as applied above, (see claim 1), in addition, Schalachman discloses a means for retrieving the telephone number from the storage section (34, 36, and 38) while the name of the city/state is entered from the keyboard (22 or 40), as disclosed at column 13, line 17 through column 16, line 54 and exhibited in figures 18 and 19;

a means for retrieving the name of the city/state from the storage section while the telephone number is entered from the input means (key board 22 or 40) to be a retrieval key, as disclosed at column 13, line 17 through column 16, line 54 and exhibited in figures 18 and 19;

Regarding **claim 3**, Schlachman discloses a state discrimination means (40) for determining whether the information input from the keyboard (22 or 40) is a telephone number or a name of a city/state, as disclosed at column 13, line 17 through column 16, line 54 and exhibited in figures 18 and 19. The additional elements claimed are recited in claims 1 and 2 and are therefore rejected based on the above as disclosed in claims 1 and 2.

Regarding **claim 4**, Schlachman discloses everything claimed as applied above, (see claim 3), in addition, Schalachman discloses wherein the user determines the dialing mode and the state discriminator determines whether the information entered is a telephone number or a city/state, as disclosed at column 13, lines 17 through column 16, line 54 and exhibited in figures 18 and 19.

Regarding **claim 5**, Schlachman discloses everything claimed as applied above, (see claim 3), in addition, Schalachman discloses wherein the retrieval key is pressed

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down and starts the retrieval of information from the storage section, as disclosed at column 13, line 17 through column 16, line 54 and exhibited in figures 18 and 19.

Regarding **claims 7 and 8**, Schlachman discloses everything claimed, in addition claims 7 and 8 are interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-5.

Allowable Subject Matter

2. **Claim 6** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

3. Applicant's arguments filed May 28, 2004 have been fully considered but they are not persuasive. Specifically application discussions regarding the Schlachman patent are not relevant to limitation disclosed in the claims. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., user knowing if the telephone number is listed of valid) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F Harold whose telephone number is 703-306-5836. The examiner can normally be reached on Monday - Friday 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JFH
September 7, 2004

Jefferey F Harold
Examiner
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XU MEI
PRIMARY EXAMINER